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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/595,167	06/15/2000	James M. Brugger	17742-002510	2793

7590 07/09/2003

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EXAMINER

RODRIGUEZ, CRIS LOIREN

ART UNIT	PAPER NUMBER
3763	16

3763

DATE MAILED: 07/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No. 09/595,167	Applicant(s) BRUGGER ET AL.	
Examiner Cris L. Rodriguez	Art Unit 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1)  Responsive to communication(s) filed on 12 June 2003.
- 2a)  This action is FINAL.
- 2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4)  Claim(s) 1-3,5-8,10-14 and 16-27 is/are pending in the application.
  - 4a) Of the above claim(s) 8,11 and 13 is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-3,5-7,10,12,14 and 16-27 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All b)  Some \* c)  None of:
    - 1.  Certified copies of the priority documents have been received.
    - 2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    - 3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a)  The translation of the foreign language provisional application has been received.
- 15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, <sup>5-6</sup>~~5,7~~, 10, 12, 14, <sup>16-23</sup>~~16-21~~, 23, and ~~27,6~~ and ~~22~~ are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulte et al (US 4,681,560) in view of Prosl et al (US 4,569,675).

Schulte discloses an implantable port (figs. 1 and 7) and a subcutaneous substance delivering method. The port 28 has a body with a flow passage having an upstream and downstream end, a pressure-responsive valve at 60 positioned in the flow passage downstream portion. However, Schulte fails to disclose the pressure-responsive valve integrally formed to the port body, the housing being made of stainless steel, and the access tube being a blunt cannula.

Prosl teaches an implantable port where the access tube has a blunt cannula. Given the teachings, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use Prosl's cannula in Schulte's implantable port. Doing so would have delivered a substance to a target site. Also, the selection of a known material based on its suitability (such as the stainless steel for the housing) has been considered as an obvious design choice, as supported by the obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). Furthermore, it would have been obvious to one of ordinary skill in the art to integrally mount the pressure-responsive valve of Schulte in the port

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body thereof, since it has been held to be within the general skill of a worker in the art to make plural parts unitary as a matter of obvious engineering choice. *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965).

3. Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulte et al in view of Kaplan et al (US 6,162,238).

Schulte discloses an implantable port (figs. 1 and 7) and a subcutaneous substance delivering method. The port 28 has a body with a flow passage having an upstream and downstream end, a pressure-responsive valve at 60 positioned in the flow passage downstream portion. However, Schulte fails to disclose the pressure-responsive valve integrally formed to the port body, the kit having instructions having the steps as claimed, and a package to contain the implantable port and the instructions.

Kaplan teaches a kit (fig. 9) including an implantable system 12,16, instructions, and a package 304 to contain the implantable port and the instructions. Given the teachings, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Schulte's kit by including instructions and a package as evidenced by Kaplan as old and well known. Also, the instructions (descriptive material) are not functionally related to the instruments or tools of the kit (which are not even a substrate for the printed matter), and, as such, do not distinguish the invention from the prior art. *In re Gulack*, (CAFC) 217 USPQ 401; *In re Miller*, (CCPA) 164 USPQ 46.

#### ***Response to Arguments***


4. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cris L. Rodriguez whose telephone number is (703) 308-2194. The examiner can normally be reached on 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on (703) 308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

July 9, 2003

  
Cris L. Rodriguez  
Examiner  
Art Unit 3763

  
BRIAN I. CASLER  
SUPERVISOR  
TECHNOLOGY CENTER 3700